

Remarks

Reconsideration of this Application is respectfully requested.

I. Status of the Claims

Upon entry of the foregoing amendment, claims 14, 20, 21, 24, 25, 30, 31, and 47-59 are pending in the application, with claims 14 and 48 being the independent claims. Claims 1-13, 16-18, 22, 23, 26-29, and 32-46 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Claims 14, 20, 21, 31, and 47 are sought to be amended. New claims 48-59 are sought to be added.

Support for the amendment to claim 14 can be found, *inter alia*, in the as-filed specification at pages 91-92, paragraph [0177] and at page 92, paragraph [0179]. Support for new claims 48-59 can be found, *inter alia*, in original claims 14 and 20-31, at pages 92-93, paragraph [0181], at page 96, paragraph [0188], at pages 97-98, paragraph [0192], and at pages 98-99, paragraph [0194]. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

II. Objection to the Specification

The Examiner has objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. (Office Action, page 3, lines 7-8). The Examiner alleges that antecedent basis for the recitation that the "assay comprises

"gambogic acid" could not be found in the specification. (Office Action, page 3, lines 17-18).

In furtherance of prosecution, the phrase "assay comprises gambogic acid" has been deleted.

Accordingly, Applicants respectfully request that the objection to the specification be withdrawn.

III. Objections to the Claims

The Examiner has objected to claims 14, 20-31, and 47 as allegedly SEQ ID NO: 1, 2, 3 or 8 is redundantly recited. (Office Action, page 4, lines 2-3).

In furtherance of prosecution, Applicants have amended claim 14 to recite only SEQ ID NO: 1.

Accordingly, Applicants respectfully request that the objection to claims 14, 20-31, and 47 be withdrawn.

The Examiner has objected to claims 20, 22, 26, and 28 under 37 C.F.R. § 1.75(c) as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim. (Office Action, page 4, lines 8-10). The Examiner alleges that "the limitations recited in these claims have been incorporated into independent claim 14, so these claims fail to further limit the methods of claim 14." (Office Action, page 4, lines 12-14).

In furtherance of prosecution, Applicants have cancelled claims 22, 26, and 28, and claim 20 has been amended in proper dependent form.

Accordingly, Applicants respectfully request that the objection to claims 20, 22, 26, and 28 be withdrawn.

IV. Rejection of Claim 31 Under 35 U.S.C. § 101

The Examiner has rejected claim 31 under 35 U.S.C. § 101 as allegedly the claimed invention is not supported by either a specific or substantial utility or a well-established utility. (Office Action, page 4, lines 20-22).

The Examiner alleges that

the specification provides no asserted utility for this method other than that recited in the method objective which is to identify potentially therapeutic anticancer compounds. However, claim 31 states that 1-(3-methyl-2-butenyl)-3,3-dimethyl-1,3,3a,4,5,12a-hexahydro-7,13-dioxo-1,5-methano-furo[3,4-d]xanthene is a potentially therapeutic anticancer compound. Therefore, since the claim already identifies 1-(3-methyl-2-butenyl)-3,3-dimethyl-1,3,3a,4,5,12a-hexahydro-7,13-dioxo-1,5-methano-furo[3,4-d]xanthene as a potentially therapeutic anticancer compound, there is no utility that would be immediately available for application in a 'real-world' context because the claim already identifies the recited compound as a potentially therapeutic anticancer compound.

(underlining original)(Office Action, page 6, lines 6-16).

In furtherance of prosecution, Applicants have amended claim 31 to recite compounds identified by the method of claim 14.

Accordingly, Applicants respectfully request that the rejection of claim 31 under 35 U.S.C. § 101 be withdrawn.

V. Rejection of Claims 14, 20-31, and 47 Under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 14, 20-31, and 47 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and

distinctly claim the subject matter which Applicants regard as their invention. (Office Action, page 7, lines 1-3). Applicants respectfully traverse the rejection.

The Examiner alleges that "since the claims lack any active process step that necessarily *identifies potentially therapeutic anticancer compounds* the claimed methods appear to be incomplete for omitting essential steps necessary to achieve the claimed objective." (italics original)(Office Action, page 8, lines 19-22).

In furtherance of prosecution, Applicants have amended claim 14 to include the active process of comparing binding between test compounds and TRRAIP to binding between TRRAIP and gambogic acid or gambogic acid-related compound.

The Examiner has also rejected claim 47 as allegedly "step (b) of claim 14, merely *monitors* whether said one or more test compounds binds to said TRRAIP, and, as explained above, the steps set forth in part (b) do not relate the step of monitoring *binding* to the identification of a *TRRAIP binding test compound per se.*" (italics original)(Office Action, page 9, lines 1-4). Applicants respectfully traverse the rejection.

In furtherance of prosecution, Applicants have amended claim 47 to clarify that the TRRAIP binding test compounds identified by the method of claim 14 are further analyzed for apoptotic activity.

Accordingly, Applicants respectfully request that the rejection of claims 14, 20-31, and 47 under 35 U.S.C. § 112, second paragraph, be withdrawn.

VI. Rejection of Claim 31 Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claim 31 under 35 U.S.C. § 112, first paragraph, as allegedly the claimed invention is not supported by either a specific and substantial

utility or a well-established utility thus, one of skill in the art would not know how to use the invention. (Office Action, page 9, lines 26-30). Applicants respectfully traverse the rejection.

The Examiner states that "the claimed invention lacks utility because it is a process for identifying compounds that are already identified. Any need to elaborate any other use for the claimed invention would constitute a need to perform undue and/or unreasonable experimentation." (Office Action, page 10, lines 9-12).

In furtherance of prosecution, Applicants have amended claim 31 to recite compounds identified by the method of claim 14.

Accordingly, Applicants respectfully request that the rejection of claim 31 under 35 U.S.C. § 112, first paragraph, be withdrawn.

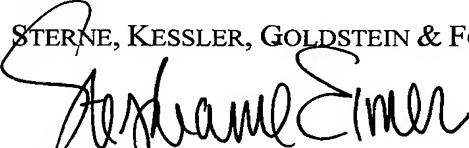
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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